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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,978	02/15/2002	Edward Sax	F-8040	1405

7590

10/09/2002

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 10/09/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/076,978

Applicant(s)

SAX ET AL.

Examiner

Victor MacArthur

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a method of constructing a fence, classified in class 256, subclass 1.
- II. Claims 16-29, drawn to a fence, classified in class 256, subclass 32.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of making a fence, as described in claims 1-15, could result in a product other than the fence disclosed in claims 16-29. For instance, a fence that does not have a wall appearance.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Young Hong Chen on 10/1/02 a provisional election was made with traverse to prosecute the invention of Group II, claims 16-29.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of ratchets in line 5 of claim 16 must be shown or the feature(s) canceled from the claim (Only one ratchet is currently shown). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 27, in line 2 it is unclear what the terminology “pre-constructed non-structural” means.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6355333 to Waggoner et al. in view of USPN 485304 to Spillinger (see marked-up copy).

Regarding claim 16, Waggoner discloses (fig.1) a fence construction system, comprising: a plurality of fence posts (12); at least two temporary ratcheting posts, one of the ratcheting posts having a plurality of holes formed therein; a plurality of ratchets secured in at least some of the holes; a plurality of high-tension tensile wires (14) running between the temporary ratcheting posts and secured to the plurality of fence posts; and a wire lath (18) secured (via 16) to the plurality of high-tension tensile wires. Waggoner does not disclose ratcheting posts or ratchets. Spillinger teaches (fig.1, 2) temporary ratcheting posts (A, B, C), one (C) of the ratcheting posts having a plurality of holes (receiving wires 100 and bolts 200) formed therein; a plurality of ratchets (a, b, c) secured (via wires 100) in at least some of the holes; and a plurality of wires (100) running between the temporary ratcheting posts; for the purpose of tightening the wires. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the fence of Waggoner to include ratchets and ratcheting posts for the purpose of tightening the wires.

As to claim 17, Waggoner discloses the fence construction system according to claim 16. Waggoner does not disclose that the tensile wires are about 12-18 gauge. It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made

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to optimize the proportion of the wire of Waggoner to be 12-18 gauge as such practice is a design consideration within the skill of the art.

As to claim 18, Waggoner discloses the fence construction system according to claim 16. Waggoner does not disclose that the high-tension tensile wires are spaced at about a 12-inch vertical separation. It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to optimize the proportion of the wire spacing of Waggoner to be about a 12-inch vertical separation as such practice is a design consideration within the skill of the art.

As to claim 19, Waggoner discloses the fence construction system according to claim 16 wherein the wire lath is metal. Waggoner does not disclose that the wire lath is galvanized metal or that the wire lath is 2.8-3.4 gauge. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of galvanized metal for laths is well known. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a galvanized metal material to construct the lath of Waggoner as such practice is a design consideration within the skill of the art.

Furthermore, it has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at

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the time the invention was made to optimize the proportion of the lath of Waggoner to be 2.8-3.4 gauge as such practice is a design consideration within the skill of the art.

As to claim 20, Waggoner discloses the fence construction system according to claim 16 further comprising a fence coating (22, 24, 26) applied to the wire lath (col.2, 1.46-col.3, 1.5).

As to claim 21, Waggoner discloses the fence construction system according to claim 20, wherein the fence coating includes a scratch coat (22) applied to the wire lath, a brown coat (24) applied to the scratch coat and a finish coat (26) applied to the brown coat (col.2, 1.46-col.3, 1.5).

As to claim 22, Waggoner discloses the fence construction system according to claim 21, wherein the scratch coat is a Portland cement mixture (col.2, 1.46-col.3, 1.5). Waggoner does not disclose that the Portland cement mixture is the type containing polymers, various fiber particles and selected sizes of aggregate. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of a Portland cement of the type containing polymers, fiber particles and selected sizes of aggregate for scratch coats is well known. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a Portland cement of the type containing polymers, fiber particles for the scratch coat of Waggoner as such practice is a design consideration within the skill of the art.

As to claim 23, Waggoner discloses the fence construction system according to claim 21, wherein the brown coat is of the same mixture as the scratch coat (col.2, 1.46-col.3, 1.5).

As to claim 24, Waggoner discloses the fence construction system according to claim 21, Waggoner does not disclose that the scratch coat and the brown coat are about 3/8". It has

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generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to optimize the proportion of the scratch coat of Waggoner to be about 3/8", as such practice is a design consideration within the skill of the art.

As to claim 25, Waggoner discloses the fence construction system according to claim 20, further comprising a paint applied on the fence coating (col.2, 1.46-col.3, 1.5).

As to claim 26, Waggoner discloses the fence construction system according to claim 25, wherein the paint is a color coat. Note that the claim language does not require both a prime coat and color coat but rather "one of a prime coat and a color coat".

As to claim 27, Waggoner discloses the fence construction system according to claim 16, further comprising a decoration column (A).

As to claim 28, Waggoner discloses (fig.1) a fence comprising a plurality of fence posts (12); a plurality of high-tension tensile wires (14) secured to the plurality of fence posts; a wire lathe (18) secured to the plurality of high-tension tensile wires; and a fence coating (22) applied to the wire lath.

As to claim 29, Waggoner discloses the fence according to claim 28, further comprising a paint applied to the surface of the fence coating (col.2, 1.46-col.3, 1.5).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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Referring to Portland cement mixture containing polymers, various fiber particles and selected sizes of aggregate:

USPN 6299679 to Montoya;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (703) 305-5701.

The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

VLM  
October 2, 2002

  
**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3600**

Attachment: one marked-up copy of USPN 485304 to Spillinger

(No Model.)

J. SPILLINGER.  
FENCE.

No. 485,304.

Patented Nov. 1, 1892.

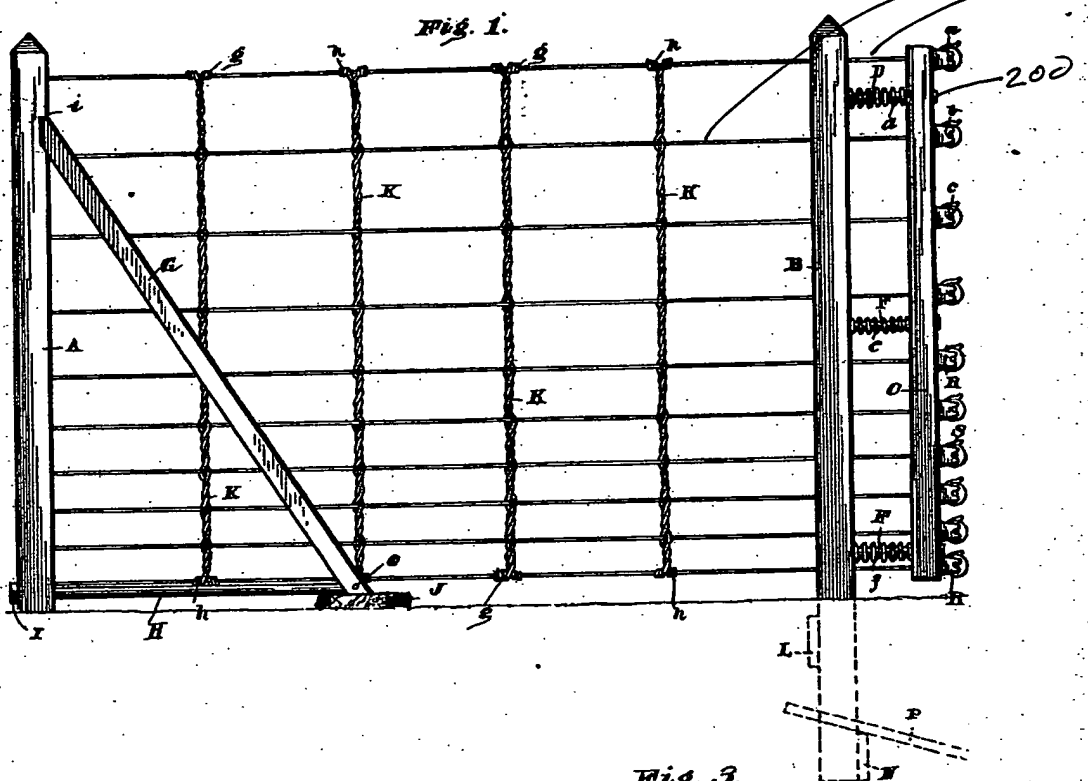


Fig. 2.

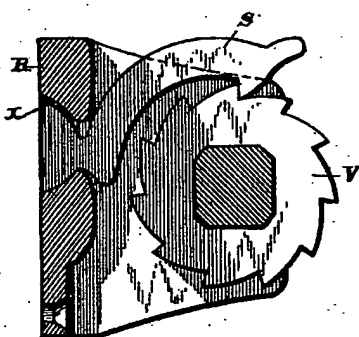
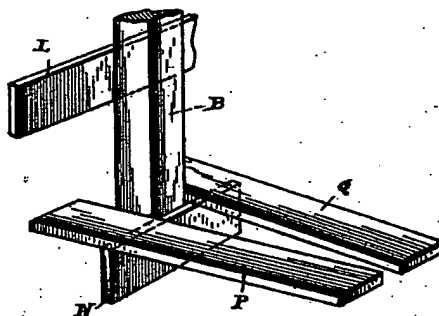


Fig. 3.



Witnesses

*Charles Ford*

*Abner Macaulay*

*By his Attorneys,*

*Chas. Snow & Co.*

Inventor  
*Joseph Spillinger*